

Amendment

U.S. Patent Appl. Serial No. 09/652,793

REMARKS

Claims 3-23 and 48-54 are pending in the subject application. Claims 3-23 and 48-52 have been examined and stand rejected, claims 1, 2 and 24-47 have been canceled, and new claims 53 and 54 have been added. Favorable reconsideration of the application and allowance of all of the pending claims are respectfully requested in view of the above amendments and the following remarks.

Applicant notes that the present application is a continuation of U.S. Patent Application Serial No. 08/698,148, filed August 15, 1996, now U.S. Patent No. 6,199,045, as indicated in the Patent Application Bibliographic Data Sheet filed March 22, 2001. The Examiner is respectfully requested to acknowledge Applicant's claim to priority under 35 U.S.C. §120 in the next communication.

Applicant hereby affirms the election without traverse of invention II as defined by the Examiner, to which claims 3-23 and 48-54 are presently drawn.

Claims 3-5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,025,261 to Ohta et al. in view of U.S. Patent No. 5,802,492 to DeLorme et al. Further, dependent claims 6-8 stand rejected in further view of U.S. Patent No. 5,365,451 to Wang et al., dependent claims 9-11 stand rejected in further view of U.S. Patent No. 5,930,729 to Khamis et al., dependent claims 12-22 stand rejected in further view of U.S. Patent No. 5,438,695 to Morimura et al., and dependent claim 23 stands rejected in further view of U.S. Patent No. 5,109,399 to Thompson. Applicant respectfully traverses these rejections for the following reasons.

Independent claim 3 sets forth a mobile communication device for communicating with a server over a communication network to receive position-related information. The claimed mobile communication device includes: a receiver that receives position signals; a processor that determines position information indicative of a present position of the mobile communication device; an input device that receives from an operator a selection signal indicative of a topic of interest; and a

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modulator/demodulator configured to transmit the position information and the selection signal to the server over the communication network and to receive position-related information from the server, wherein the position-related information is a function of the position information and the selection signal.

As the Examiner correctly acknowledges, Ohta fails to disclose an input device that receives from an operator a selection signal indicative of a topic of interest, as required by claim 3. Although not acknowledged by the Examiner, Ohta also fails to disclose or suggest a modulator/demodulator that transmits both position information and the selection signal to a server over a communication network and that receives position-related information from the server, wherein the position-related information is a function of both the position information and the selection signal, as required by claim 3.

This difference between the claimed invention and Ohta is more fundamental than suggested by the Examiner's analysis. The system described by Ohta is simply a map displaying system. Position data is collected by Ohta's vehicle and transmitted to a remote key station that supplies related map data to the vehicle in return. Not only does Ohta lack an input device for receiving a selection signal indicative of a topic of interest; there is not the slightest suggestion in Ohta's disclosure to accept any sort of selection signal from a user or to receive position-related information from a remote server based on both position information and a topic selection signal. The map data accessed at Ohta's remote key station is retrieved based only on position data. Ohta does not disclose or suggest also transmitting a selection signal along with the position data, and then retrieving map data (or any kind of information) as a function of both position data and a selection signal indicative of a topic of interest.

The requirement of claim 3 that the modulator/demodulator transmit both position information and the selection signal to a server over a communication network and that the modulator/demodulator receive from the server position-related information that is a function of both the position information and the selection signal is a fundamental aspect of the novelty of

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Applicant's claimed invention. In essence, the claimed device retrieves position-related information from a remote server based on the combination of position information and a topic selection signal. There is not the slightest suggestion in Ohta's disclosure of how or why one would expand a map displaying system to be a fundamentally different type of system that permits selection of a topic of interest and then conveys information on that topic of interest as a function of user position and of the topic selection itself.

DeLorme does not make up for the deficiencies of Ohta, since DeLorme also fails to disclose or suggest a modulator/demodulator that transmits position information and a selection signal indicative of a selected topic of interest to a server over a communication network and that receives position-related information from the server, wherein the position-related information is a function of the position information and the selection signal, as required by claim 3. DeLorme essentially discloses a desktop computer system that permits a user to engage in an iterative trip planning process in which a travel route can be prospectively determined or adjusted based on user-specified points of interest which lie along a travel route. Included among the various embodiments described by DeLorme is an in-vehicle embodiment in which a user can view the vehicle's current position and can also browse information about points of interest. DeLorme's system also includes a GPS interface capable of receiving position information from a GPS receiver.

However, whether desktop or in-vehicle, the system of DeLorme involves retrieving information stored in the system. In particular, there is no suggestion in the description of DeLorme's in-vehicle embodiment of a modulator/demodulator that transmits position information and a selection signal indicative of a selected topic of interest to a server over a communication network and that receives position-related information from the server, wherein the position-related information is a function of the position information and the selection signal. Rather, the map and point of interest information is contained within DeLorme's device. Consequently, there is no need in DeLorme's system to transmit position information and a selection signal to a remote server and to receive corresponding position-related information from a remote server. This is an important and

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non-obvious advantage that the claimed invention has over systems such as DeLorme. By maintaining the position-related information at a remote server and indexing this information with the combination of the position information and the selection signal, the claimed invention avoids the need to maintain on-board databases of information and the corresponding problem of keeping such databases up to date. In any event, there is simply no teaching in DeLorme of a modulator/demodulator that operates in the manner claimed.

Further, claim 3 requires that the position-related information be a function of both the position information and the topic selection signal. In contrast, the point of interest information accessed in DeLorme is not a function of position information indicative of the present position of the device. In DeLorme's desktop embodiment, the location of the desktop system is entirely irrelevant to the iterative trip planning process performed on the system. Even in DeLorme's in-vehicle embodiment, the selection and display of a point of interest is decoupled from the current position of the vehicle. For example, at column 18, lines 1-9, DeLorme explains that current position of the vehicle is displayed on a visual route map, while at the same time, a passenger can browse through places to eat in Seattle using a restaurant list box. As described, this restaurant list box is not retrieved as a function of the current position of the vehicle, but rather as a separate selection of the passenger, which selection can be independent of the current position of the vehicle (presumably, the passenger would be free to "browse" restaurant information in other locales). Thus, DeLorme does not suggest receiving position-related information as a function of both current position information and a selected topic of interest.

Since Ohta and DeLorme do not disclose or suggest a modulator/demodulator that transmits position information and a selection signal indicative of a selected topic of interest to a server over a communication network and that receives position-related information from the server, wherein the position-related information is a function of the position information and the selection signal, the subject matter of claim 3 would not have been (and could not have been) obvious from any combination of these documents.

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Moreover, Applicant respectfully submits that there is no obvious way to modify Ohta in view of DeLorme to meet the limitations of claim 3. Ohta is simply a map displaying system, wherein map data is retrieved from a remote key station. In order meet the limitations of claim 3, one would have to dramatically alter Ohta's system to be something completely different. First, a user interface (together with supporting processing) would be required in order to present the user with the opportunity to select a topic of interest. Second, the selected topic of interest would need to be transmitted along with position information over a communication network to a server. Third, position-related information that is a function of both the position information and the topic selection signal would have to be received by the device. Of course, to support such modifications, one would also have to develop a remote server support system that maintains extensive databases of information that can be accessed by the position information and the topic of interest selection signal. DeLorme could not possibly suggest all these modifications, since DeLorme's system itself does not operate in this manner. More generally, Applicant respectfully submits that no reference could reasonably suggest modifying a map displaying system such as Ohta's to be a position-related information retrieval system given the extensive differences between such systems. Only by use of impermissible hindsight could one reasonably conclude that Ohta could be modified to meet the requirements of claim 3. For all of the foregoing reasons, Applicant respectfully submits that claim 3 and its dependent claims 4 and 5 would not have been obvious over Ohta in view of DeLorme.

With regard to the rejections of dependent claims 6-23, Wang, Khamis, Morimura, and Thompson have been further cited for particular limitations found in certain dependent claims. However, like Ohta and DeLorme, none of these documents discloses or suggests a modulator/demodulator that transmits position information and a selection signal indicative of a selected topic of interest to a server over a communication network and that receives position-related information from the server, wherein the position-related information is a function of the position information and the selection signal. Thus, no combination of these documents would have (or could have) rendered obvious the subject matter of parent claim 3, and dependent claims 4-23 should

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be patentable at least by virtue of their dependence on parent claim 3. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejections of claims 3-23.

Claim 48 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ohta in view of DeLorme and Thompson. Further, dependent claims 49-52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ohta in view of U.S. Patent No. 5,703,598 to Emmons. Applicant respectfully traverses these rejections for the following reasons.

Independent claim 48 sets forth a mobile communication device for selectively reporting position information. The claimed mobile communication device requires: a receiver that receives position signals; a processor that determines the position information indicative of the present position of the mobile communication device from the position signals; a modulator/demodulator that transmits the position information to a destination over a communication network; and a position reporting enabling unit configured to selectively enable and disable transmission of the position information while said mobile communication device is operational.

As a preliminary matter, Applicant notes that, while dependent claims 49-52 have been rejected over the combination of Ohta and Emmons, independent claim 48 has not been rejected over the combination of Ohta and Emmons. Only the combination of Ohta, DeLorme and Thompson has been cited to reject independent claim 48.

None of Ohta, DeLorme and Thompson discloses or suggests a position reporting enabling unit configured to selectively enable and disable transmission of the position information while the mobile communication device is operational, as required by claim 48. In paragraph 13 of the Office Action, the Examiner explicitly acknowledges that "In the above, it does not include the enabling, disabling the position reporting." Whether this acknowledgement applies only to Ohta or to DeLorme and Thompson as well is not clear. Nevertheless, there is no mention of anything analogous to the claimed position reporting enabling unit in any of these documents. Consequently, no combination of these documents could have rendered obvious the subject matter of claim 48. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of

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claim 48. Applicant notes that claim 48 has not been amended; thus, any new ground of rejection of claim 48 must be non-final.

With regard to the rejection of dependent claims 49-52 over Ohta and Emmons, Applicant respectfully disagrees that, based upon Emmons disclosure, it would have been obvious to modify Ohta's system to include a position reporting enabling unit that selectively enables and disables transmission of position information. As previously summarized, Ohta discloses a navigation system wherein a mobile object reports its position to a remote key station that sends corresponding map data to the mobile object for display.

Emmons discloses a system for tracking stolen vehicles. The system of Emmons includes a GPS transmitter/receiver that can be activated only by reception of a remotely-transmitted coded signal (see Emmons, col. 1, lines 54-57; col. 2, lines 58-65). A local timer subsequently disables the GPS transmitter/receiver after a predetermined time. Importantly, since the GPS transmitter/receiver is onboard a stolen vehicle, the GPS transmitter/receiver cannot be enabled or even accessed locally. In fact, the GPS transmitter/receiver is purposely mounted in a location that is difficult access.

Applicant respectfully submits that there is no meaningful or obvious way to combine Ohta and Emmons. At a general level, Ohta is an onboard mapping system, whereas Emmons is a stolen vehicle tracking system. While Ohta's system displays onboard map information, Emmons's system is designed to be hidden from the vehicle's passengers. These systems are so fundamentally different from each other that Emmons would not reasonably have suggested anything about modifying Ohta's system at the time the present invention was made without the use of impermissible hindsight.

More particularly, Emmons teaches remotely activating an onboard device for reporting position. Clearly, Emmons does not disclose and, in fact, teaches away from locally enabling an onboard device for reporting position (since this would require the thieves themselves to activate the device). Even assuming for the sake of argument that this teaching has relevance to Ohta, the resultant modification to Ohta would presumably be the capability to remotely activate Ohta's onboard mapping system and the exclusion of the capability to locally activate Ohta's onboard

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mapping system. This would not be an obvious modification to Ohta's system, since the onboard user of the mapping system would have no control over when the system was operational. While remote control of activation is desirable where the passengers have stolen the vehicle (as in Emmons), remote activation is not desirable for activating an onboard mapping system. Since it would not have been obvious to modify the system of Ohta in any reasonable manner based on the teachings of Emmons, the subject matter of claims 49-52 would not have been obvious from these documents. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 49-52.

With particular regard to dependent claim 49, which requires a position reporting enabling unit that comprises an enable/disable switch on the mobile communication device, neither Ohta nor Emmons suggests such a switch. Again, as the Examiner acknowledges, Ohta does not suggest a position reporting enabling unit at all. Emmons teaches enabling position reporting from a remote location and explicitly teaches away from having a capability to enable position reporting from the mobile device itself (since control over activation and deactivation by the thieves is undesirable). Thus, for these additional reasons, the subject matter of dependent claim 49 would not have been obvious in view of the cited documents.

Applicant has added new claims 53 and 54, which depend from independent claim 48 and which should therefore be allowable for at least the foregoing reasons. Claim 53 requires the position reporting enabling unit to selectively enable and disable transmission of the position information based on input from a mobile user of the mobile communication device. Claim 54 requires a user interface that permits a mobile user of the mobile communication device to communicate over a communication network, wherein the modulator/demodulator transmits communication signals received from the user interface and supplies received communication signals to the user interface. Support for claims 53 and 54 is found throughout the specification.

In view of the foregoing, Applicant respectfully requests the Examiner to find the application to be in condition for allowance with claims 3-23 and 48-54. However, if for any reason the

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Examiner feels that the application is not now in condition for allowance, the Examiner is respectfully requested to call the undersigned attorney to discuss any unresolved issues and to expedite the disposition of the application.

Although two dependent claims have been added by the above amendments, no excess claims fees should be due at this time, since several claims have been canceled. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 05-0460.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'P. J. Finnan', written over a horizontal line.

Patrick J. Finnan

Registration No. 39,189

EDELL, SHAPIRO, FINNAN & LYTLE, LLC
1901 Research Boulevard, Suite 400
Rockville, Maryland 20850-3164
(301) 424-3640

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APPENDIX

Please amend claim 49 as follows.

49. (Amended) The mobile communication device of claim 48, wherein said position reporting enabling unit [is] comprises an enable/disable switch on the mobile communication device.